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IBM CORPORATION
IPLAW IQ0A/40-3
1701 NORTH STREET
ENDICOTT, NY 13760

EXAMINER	
RICHER, AARON M	

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/896,802
Filing Date: June 29, 2001
Appellant(s): BREDOW ET AL.

D. Randal Ayers

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed August 4, 2005 appealing from the Office action mailed March 1, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6211878	Cheng	4-2001
6,198,473	Armstrong	3-2001
6,567,079	Smailagic	5-2003
6,307,573	Barros	10-2001

5,877,766 Bates 3-1999

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 14, 27, and 29 are rejected under 35 U.S.C. 102(e). Claims 2-13, 15-26, and 28 are rejected under 35 U.S.C. 103(a). These rejections are set forth in a prior Office Action, mailed on March 1, 2005.

(10) Response to Argument

I. Introduction

Appellant gives background on the invention and argues that the Office's 103(a) rejections are generally insufficient. No arguments pertaining to specific claim rejections were presented in this section.

II. As to the argument that claims 1, 14, 27, and 29 are not anticipated by Cheng:

A. 1. Appellant argues that the connection between boxes 42 and 45 of figure 1 of Cheng does not teach the "scrolling output" recitation.

Appellant argues that these boxes instead teach back and forward buttons on a device. Appellant further argues that a URL is not determined in response to a scrolling output, stating that a scrolling output is instead used to advance or regress through information on a webpage. The examiner notes that based solely on figure 1, it is unclear whether the back/forward functions are initiated by buttons or scrolling action. There is nothing in figure 1 that specifically says these functions are buttons. Appellant cites col. 6, lines 24-26 as disclosing buttons that are used to access "display previous

page mode" in box 45, although this text makes no mention of the link between boxes 42 and 45. On the other hand, col. 6, lines 8-19 of Cheng states that "user interface devices or buttons... are designed for page up and page down functions, backward and forward movement of highlighted or selected text, or frame advance for a web browser." This text shows that buttons are an exemplary embodiment of the Cheng invention, and that the Cheng invention is not limited to using only buttons, but can use other user interface devices as well.

Since a scroll wheel is a user interface device, and is specifically disclosed by figure 3 of Cheng, it seems logical to assume that a scroll wheel could be used to perform a back/forward function. The examiner admits that while this feature is implied, it is not expressly disclosed, and therefore the link between elements 42 and 45 in figure 1 of Cheng is not the best grounds of rejection for claim 1. This is why the link was only briefly mentioned in previous Office Actions as support for other rejections and not as the main grounds of any rejection. See p. 8, paragraph 25 of the previous Office Action. The main grounds of rejection applicable to claim 1 use the previously cited portions of Cheng concerning "frame turning mode" and "display previous page mode". These will be addressed in later arguments.

2. a. Appellant argues that the connection between boxes 46 and 45 of figure 1 of Cheng does not teach the "scrolling output" recitation because Cheng does not disclose determining the URL of a web page.

Appellant argues that "frame turning mode" and "display previous page mode" are actions taken to navigate through a single web page. As to "frame turning mode",

the examiner notes that because each frame on a web page is technically a separate page with a different URL[1], and because the scroll wheel is used to access each frame, determining a URL of each page in response to a scrolling output is inherent to the invention of Cheng. If no URL were determined for each frame, the browser of Cheng would be unable to identify a frame or retrieve a frame for display.

Figures 4-5 and col. 8, lines 10-20 of Cheng disclose a similar system, with hyperlinks or images instead of frames. Col. 10, lines 39-67 and col. 11, lines 1-9 explain how a page is parsed to find URLs of images or other pages. Each hyperlink or image has a unique URL that must be determined in order to display the hyperlink or image. The effect is similar to scrolling through URLs in the address bar of Microsoft Internet Explorer®, using the scroll wheel to determine which web address to visit next. This portion of the disclosure of Cheng clarifies the originally cited text to show that Cheng does indeed teach determining a URL of a web page, and accessing that page using a browser. It is further noted that the claims of appellant's invention, specifically claim 1, are so broadly stated that virtually any browser that uses a scroll wheel to select a URL can read on the limitations therein.

It is believed that Cheng's disclosure regarding "frame turning mode" is enough evidence to show that Cheng anticipates the limitations of claim 1. However, since previous Office Actions extensively cited a "display previous page mode" in Cheng, the arguments against these rejections will be addressed as well. As to "display previous

[1] By visiting a framed website, such as http://www.htmlcodetutorial.com/frames/frame1_top.html, right-clicking, and selecting "Properties", one can see that the addresses (URLs) of two frames in a web page differ. Note that this and other websites referred to in the Examiner's Answer are not cited references. They are simply used as examples to clarify previous arguments with regard to the Cheng reference.

page mode", appellant argues that Cheng discloses previous pages of a "web page document", and that this does not require determination of a URL because it is simply navigating through screens on a single web page. The examiner notes that there is nothing in Cheng or any other reference to imply that a "web page document" is limited to one URL. For instance, Microsoft PowerPoint® slides are part of a single document, but are often turned into multiple web pages for easy navigation and viewing[2]. Similarly, the applicant's specification on pages 1-2 discloses a "catalog". A catalog would normally be seen as a single document, but for the purposes of converting to a web-accessible version, it becomes a linked set of many web pages, all with different URLs.

It is further noted that the "display previous page mode" disclosed by Cheng can be accessed by a "back" or "forward" function (col. 6, lines 20-31). It is well-known in the art that "back" and "forward" functions in a browser are for navigation between previously visited URLs. There is no disclosure to imply that this is not the case in the invention of Cheng. In fact, Cheng discloses separate "page up" and "page down" functions in col. 6, lines 54-65. Note that figure 1, element 56 has "page up/page down" and "back/forward" commands going to two different boxes, showing that these two functions are not identical. One skilled in the art would not assume that back/forward commands have functions in the Cheng invention that are different from every other web browser unless Cheng specifically disclosed this. The fact that Cheng provides for "page up" and "page down" functions separately implies that the back and forward

[2] See http://www.rdpslides.com/pptools/ppt2html/basic/basic2.htm for an example of a single PowerPoint document turned into a series of web pages with different URLs.

functions of Cheng are not used for this purpose, and there is nothing in the disclosure of Cheng to show that back and forward functions do not retrieve different URLs.

b. Appellant argues that the connection between boxes 46 and 45 of figure 1 of Cheng does not teach the "scrolling output" recitation because the display previous page mode is not entered in response to a scrolling output.

Appellant argues that fig. 1 discloses that when a scrolling signal is received while in frame turning mode, a "turn to frame mode" (box 54) is entered. According to the appellant, this is a direct contradiction of previously cited text (col. 6, lines 24-28), which shows that a scroll signal can bring the invention of Cheng into "display previous page mode". The examiner maintains that there is no contradiction inherent in this disclosure. There is nothing that implies a scroll signal cannot have two functions. For instance, a scroll signal in one direction may have one effect, while a scroll signal in another direction may have a second effect. A scroll signal could also have one effect if frames exist, and another if they do not. In general, this is the way scroll signals work, dependent on direction and previous conditions.

Col. 6, lines 24-28 discloses activation of a previous page mode by "a combination of the web browser previously being in a frame turning mode... and generation of a scroll signal". There is nothing in this disclosure that says that *all* scroll signals bring the invention into "display previous page mode", just that generation of *a* scroll signal will have this effect. Based on this text, one skilled in the art would not conclude that a contradiction exists in Cheng's disclosure that renders part of the

disclosure useless. However, even assuming that appellant is correct, and *all* scroll signals in "frame turning mode" advance or regress frames, claim 1 would still be anticipated by Cheng. See the response to arguments under heading II.A.2.a for an explanation of how "frame turning mode" anticipates claim 1.

B. Appellant argues that claim 29 is independently patentable over Cheng because Cheng does not disclose a URL determined "in response only to the scrolling output".

Appellant notes that col. 6, lines 24-29 state that forward/back buttons can be used to navigate between pages. Appellant argues that this is an example of a URL not determined in response to a scrolling output, and therefore the Cheng reference cannot be used to reject a claim that recites determining a URL "only" in response to scrolling. The examiner takes the position that this argument is based on an overly narrow view of a broad claim. It is also noted that this argument directly contradicts the applicant's own specification, which states on page 8 that "The viewer may enter and exit the scrolling mode of the present invention by selecting from a menu of options... When scrolling mode is active, the scroll mouse 150 provides scrolling output in response to the viewer's manipulation of the scrolling mechanism 151." Appellant has construed claim 29 to encompass an invention that only determines a URL in response to scrolling output, while the specification of the applicant's invention actually discloses that the scrolling mode can be turned on and off.

Reading claim 1, which claim 29 is dependent on, along with claim 29 gives a claim that recites in part "....detecting scrolling output; responsive to the scrolling output,

determining a URL of a web page, wherein the URL of the web page is determined in response only to the scrolling output..." When reading this portion of the claim, and in light of the specification of the invention, it becomes clear that the broadest reasonable interpretation of claim 29 is that of an invention that determines a URL in response only to the scrolling output *if scrolling output has been detected.* The italicized phrase is a part of claim 1 essential to claim 29.

Referring to the Cheng reference, if a scrolling signal is received while the invention is in "frame turning mode", the mode then becomes "display previous page mode" (col. 6, lines 20-31) or the advancing or regression of frames takes place (col. 6, lines 51-53). *If* the scrolling signal is detected, *only* the scrolling signal has been used to determine which URL to access. No further action by the user, such as a key press, is necessary.

III. As to the argument that claims 2 and 15 are patentable over the cited art:

Appellant argues that these claims are patentable for the same reasons that claims 1 and 14 are patentable. As no other arguments were presented for these claims, the response to arguments under heading II applies to the arguments of these claims as well.

IV. As to the argument that claims 3-4, 8-13, 16-17, 21-26, and 28 are patentable over the cited art:

A. 1. Appellant argues that the cited art does not disclose a set of linked web pages.

The examiner notes that the previous rejection cited col. 5, line 65-col. 6, line 53 of Cheng as disclosing linked web pages, stating on p. 4, paragraph 12 that "previous pages can be considered as linked web pages". Because previous pages are saved in a browser history in order of previous viewing, a previous page can be considered linked to a current page. Appellant argues that the "display previous page mode" does not retrieve a different web page with a different URL, and therefore does not disclose a set of linked web pages. This argument has been previously addressed under heading II.A.2.a.

However, even if the appellant is correct, and the "display previous page mode" does not retrieve a unique web page, Cheng still discloses the "advancing or regression of frames due to a scrolling signal". Each frame of a web page is a unique URL, as stated previously (see section II.A.2.a). These frames are "linked web pages" in at least two ways: They are linked in a parent page, which indicates to a browser which URLs make up the frames in a browser[3], and possibly how large each frame should be inside the browser. They are further linked in the display of the browser, as the size and position of one frame determines the size and position of other frames.

2. Appellant argues that the cited art does not teach determining a web page URL in response to the sense of direction of a scrolling output.

The examiner notes that the previous rejection recited on p. 4, paragraph 12, that the scrolling signal can advance or regress pages depending on a direction of the scrolling signal. The advancing or regression of frames is supported by col. 6, lines 51-

[3] See the source code of http://www.htmlcodetutorial.com/frames/frame1_top.html for an example.

53 of Cheng, while the "sense of direction" is supported by the inherent characteristics of scroll wheels. By definition, a scroll wheel sends out a scrolling signal based on a direction. This is further supported by figures 3, 9, and 10 of Chang, which show a wheel that can be moved in two directions by a person's hand, and col. 6, lines 9-11, which discloses "relative rotation" of a scroll wheel. Appellant further refers to arguments in section II of the appeal brief, and those arguments have been addressed in section II of this Examiner's Answer.

B. Appellant argues that claims 8, 10-11, 21, and 23-24 are patentable over the cited art because the forward/back instructions disclosed by Cheng do not correspond to the next/previous instructions claimed by the applicant.

The examiner notes that claim 8 recites a "...URL...associated with a next button of a source page when the sense of direction is forward and the URL is associated with a previous button of the source page when the sense of direction is backward." Cheng recites a "display previous page mode" as in col. 6, lines 20-31 and provides for advancing and regressing through frames as in col. 6, lines 51-53. Cheng also discloses in col. 6, lines 20-31 that "back" and "forward" buttons can be used in place of the scrolling for navigation, but provide the same associated function. The previous rejection pointed out that "next" and "previous" buttons are well-known in the art, and that a "back" function on a browser is similar to a "previous" button on a page, just as a "forward" is similar to a "next". It is noted that while there may be slight differences between a "back" button and the "previous" button claimed by the applicant, both perform fundamentally the same function: Both load web pages that are positioned

before a current page in an order of linked web pages. Similarly, both "forward" and "next" buttons are used to load web pages that are in a position after a current page in an order of linked web pages.

Even if one were to assume the appellant's argument that a "forward" button is fundamentally different from a "next" button is correct, the cited text of Cheng clearly provides for forward and backward navigation and Official Notice has been used in the previous rejection to show that "next" and "previous" buttons are easily programmed in HTML[4] and Java. In either case, the examiner disagrees with appellant's assertion that another citation to a reference is necessary. Official Notice has been properly applied to claim 8, dating back to the first Office Action in the case, mailed out August 22, 2003. Considering that Cheng also provides for scrolling through HTML hyperlinks (fig. 4; col. 8, lines 10-15), and that a "next" or "previous" button on a web page is often an HTML hyperlink as described above, it would be obvious to one skilled in the art that the Cheng reference can be used to scroll to a "next" or "previous" hyperlink and determine an associated URL. See section II.A.2.a of this Examiner's Answer for further information about Cheng determining a URL from a hyperlink.

V. As to the argument that claims 5 and 18 are patentable over the cited art:

Appellant argues that these claims are patentable for the same reasons that claims 1 and 14 are patentable. As no other arguments were presented for these

[4] See http://www.rdpslides.com/pptools/ppt2html/basic/basic2.htm for an example of HTML next and previous buttons. Also see the results page of any Internet search engine for further examples.

claims, the response to arguments under heading II applies to the arguments of these claims as well.

VI. As to the argument that claims 6 and 19 are patentable over the cited art:

Appellant argues that these claims are patentable for the same reasons that claims 1 and 14 are patentable. As no other arguments were presented for these claims, the response to arguments under heading II applies to the arguments of these claims as well.

VII. As to the argument that claims 7 and 20 are patentable over the cited art:

Appellant argues that these claims are patentable for the same reasons that claims 1 and 14 are patentable. As no other arguments were presented for these claims, the response to arguments under heading II applies to the arguments of these claims as well.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Aaron Richer

November 21, 2005

Conferees:

Aaron Richer

Matthew Bella

Bipin Shalwala

MATTHEW C. BELLA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600